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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 919,595	07 31 2001	Ashish K. Khandpur	56784US002	2530

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05 23 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 15

Office Action Summary

Application No.

09/919,595

Applicant(s)

KHANDPUR ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.

4) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-445)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s)

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

Response to Amendment

3. Claims 1-10, 12, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gehlsen et al. (US 6103152), substantially for the reasons set forth in the Advisory of Paper No. 13; section 5 of Paper No. 11; and section 4 of Paper No. 3, together with the following additional observations.

With respect to Applicants' Response arguing that Gehlsen "requires electron beam crosslinking of the foam in order to achieve high cohesive strength and/or high modulus" (Response, page 2, third paragraph), the Examiner notes that Gehlsen expressly teaches that "In some cases, e.g., where high cohesive strength and/or high modulus is needed, the foam may be crosslinked" (column 2, lines 5-7). As such, clearly Gehlsen's teaching shows that crosslinking is an optional means to improve the aforementioned properties, and it would have been obvious to one of ordinary skill in the art to lightly crosslink (i.e., low gel content) the adhesive article, if necessary, since high crosslinking density would be inherently detrimental to its pressure sensitive adhesive property. It has been held that where the general conditions of a claim are disclosed in

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the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

With respect to Applicants' argument that Gehlsen does not teach a pressure sensitive adhesive containing a polyarylene oxide polymer (Response, page 3, first complete paragraph), the Examiner reiterates (see section 5 of Paper No. 11) that Gehlsen expressly teaches the use of polyphenylene oxide (column 7, line 31), which is inherently a polyarylene oxide, and also exactly the same polymer PPO used by Applicants in Examples 1-3 (Specification, page 26, lines 12-26).

With respect to Applicants' argument that the present application teaches screw temperatures significantly higher than those taught by Gehlsen (Response, page 3, bottom paragraph), the Examiner notes that none of the elected independent claims recites any process limitation. Also, it should be pointed out that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Note MPEP 2113 for a more detailed description.

4. This is a continuation of applicant's earlier Application No. 09/919595. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
May 21, 2003

DANIEL ZIRKEL
PRIMARY EXAMINER
GROUP 1-2004